UNITED STATES PATENT AND TRADEMARK OFFICE

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/709,182	SNYDER, THOMAS DAVID
	Examiner	Art Unit
	SHEILA B. SMITH	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 December 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-37</u> is/are pending in the application.

    4a) Of the above claim(s) <u>2,3,17 and 18</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,4-16 and 19-37</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>9/16/05</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 26 are rejected under 35 U.S.C. 101 because the claim calls for computer product, computer–related product such as software, data structures, program code and collections of data are also evaluated for a practical application.

The claimed invention is directed to non-statutory subject matter. The claimed computer product is disclosed as a computer readable medium which may be electromagnetic, infared, or propagation medium which essentially is a signal. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result. Further, the claimed limitation computer usable or computer readable medium is disclosed as paper or another suitable medium upon which the program is printed constitutes printed matter. However, the

examiner need not give patentable weight to printed matter absent a new and unobvious

functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d

1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d

1862 (Fed. Cir. 2004).

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Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

1.   Claims 1, 4-6, 8, 9, 11-16, 19- 21, 23, 24, 26-30,32-36 are rejected under 35 U.S.C.

103(a) as being unpatentable over Johnson (U. S. Patent Publication Number 2005/0054333) in

view of Borella (U. S. Patent Publication Number 2006/0148457).

Regarding claim 1, Johnson discloses, a method of storing a phone number within a

mobile phone, said phone number received service, the method comprising: placing a call to an

information service to obtain a requested phone number, detecting the requested phone number

from the information service, and storing the requested phone number returned from the

information service within the mobile phone (which reads on paragraphs 0006-0009). However,

Johnson fails to disclose wherein the requested phone number is returned audibly from the

information service to the mobile phone, the detecting the requested number returned from the

information service comprising using voice recognition algorithms to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number.

In the same field of endeavor, Borella discloses a method and apparatus for determination of a reply address in a voice signal. In addition Borella discloses the requested phone number is returned audibly from the information service to the mobile phone (which reads on paragraph 0016), the detecting the requested number returned from the information service comprising using voice recognition algorithms (which reads on paragraph 0016) to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number (which reads on paragraph 0013 and 0046).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Johnson by specifically providing for the capability to receive the requested phone number, returned audibly from the information service to the mobile phone, using voice recognition algorithms to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number for the purpose of making the response more convenient and less prone to errors.

Regarding claim 4, Johnson discloses storing the requested phone number returned from the information service within the mobile phone comprises (which reads on "If the user chooses to download the telephone number to his wireless device 102, step 206, the server 116 sends the telephone number as a data message to the wireless device 102., After the directory information is received, step 208, an application in the wireless device 102 creates an entry in its telephone

book, step 210, and stores the directory information in the entry, step 212. The steps of creating

the entry and storing the information can be done in the background, as the result of the user

accepting to download the telephone number" as exhibited in figure 2, and as disclosed in

paragraphs 0020-0021), having the mobile phone prompt the user whether to store the returned

phone number (which reads on paragraphs 0020. 0021)).

Regarding claim 5, Johnson discloses storing the requested phone number returned from

the information service within the mobile phone further comprises having the mobile phone

prompt the user where to store the returned phone number (which reads on "If the user chooses

to download the telephone number to his wireless device 102, step 206, the server 116 sends the

telephone number as a data message to the wireless device 102., After the directory information

is received, step 208, an application in the wireless device 102 creates an entry in its telephone

book, step 210, and stores the directory information in the entry, step 212. The steps of creating

the entry and storing the information can be done in the background, as the result of the user

accepting to download the telephone number, When the server 116 downloads the information to

the wireless device 102, the information is in a predetermined format, so the receiving end can

readily identify the type of information and handle it properly. If the information relates to a

telephone directory entry, it may have only two data fields, name and telephone number, or many

fields such as the fields illustrated in FIG. 5. FIG. 5 is an example of a telephone directory 502

for a wireless device on paragraphs 0020, 0021, and 0027).

Regarding claim 6, Johnson discloses returned phone number is stored within the mobile phone's phonebook directory (which reads on paragraphs 0006-0009).

Regarding claim 8, Johnson discloses prompting the user whether to automatically dial the returned phone number (which reads on paragraphs 0020).

Regarding claim 9, Johnson discloses storing the requested phone number returned from the information service within the mobile phone comprises having the mobile phone automatically store the returned phone number within the mobile phones phonebook directory (which reads on paragraphs 0006-0009).

Regarding claim 11, Johnson discloses a method of storing a phone number within a mobile, said phone service, the method comprising: placing a call to an information quested phone number (which reads on paragraphs 0006-0009), requesting that the requested phone number be sent in an SMS text message to the mobile phone; and receiving an SMS text message containing the requested phone (which reads on paragraphs 0020) phone number and storing the phone number contained in the SMS text message (which reads on paragraph 0021). However Johnson fails to specifically discloses detecting that a number of the called information service is stored in a predetermined table of information service numbers activating a process for detecting and storing a received phone number responsive to the detecting the number of the called information service being stored in the predetermined table of information service numbers.

The examiner contends that this limitation would have been obvious to one of ordinary skill in the art, since Johnson discloses the use of "the user chooses to download the direction the

server sends the instruction to the wireless device the instruction it creates an enry in a

appropriate directory and stores the direction in this entry. If the user has trouble recalling the

direction, the user can lool up the entry corresponding to his friend in the direction directory and

the direction is displayed on his wireless device" (as disclosed in paragraph 0031, and 0032) for

the purpose of locating and using the information received when it is needed.

     Regarding claim 12, Johnson discloses having the mobile phone prompt the mobile

phone user whether to automatically dial the phone number contained in the SMS text message

(which reads on "In addition to prompting whether the user wants to be automatially connected

to the destination party, the data message can be sent via short message service" as disclosd in

paragraphs 0020). However, Johnson fails to specifically disclose opening the SMS text

message.

     The examiner take official notice that opening the SMS text message would have been

obvious to one skill in the art for the purpose to obtain the information contained in the message.

     Regarding claim 13, Johnson discloses having the mobile phone prompt the mobile

phone user whether to store the phone number contained in the SMS text message (which reads

on paragraphs 0020) before the storing the phone number contained in the SMS text message

(which reads on "the user chooses to download the information the server sends the information

as a data message to the wireless device" paragraph 0024). However, Johnson fails to

specifically disclose opening the SMS text message.

     The examiner take official notice that opening the SMS text message would have been

obvious to one skill in the art for the purpose to obtain the information contained in the message.

Regarding claim 14, Johnson discloses having the user where to store the mobile phone prompt phone number contained in the SMS text message (which reads on paragraphs 0024).

Regarding claim 15, Johnson discloses the phone number the SMS text message can be stored within phone's phonebook directory (which reads on paragraphs 0020- 0021).

Regarding claim 16, Johnson discloses a computer program number within a mobile phone, said received from an information service, the computer product for storing a phone number reprogram product comprising: computer program code (which reads on paragraph 0034) for placing a call to an information service to obtain a requested phone number, computer program code for detecting the requested phone number returned from and the information service, computer program code number returned from the mobile phone (which reads on paragraphs 0006-0009). However, Johnson fails to disclose wherein the requested phone number is returned audibly from the information service to the mobile phone, the detecting the requested number returned from the information service comprising using voice recognition algorithms to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number.

In the same field of endeavor, Borella discloses a method and apparatus for determination of a reply address in a voice signal. In addition Borella discloses the requested phone number is returned audibly from the information service to the mobile phone (which reads on paragraph 0016), the detecting the requested number returned from the information service comprising using voice recognition algorithms (which reads on paragraph 0016) to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number (which reads on paragraph 0013 and 0043).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Johnson by specifically providing for the requested phone number is returned audibly from the information service to the mobile phone, the detecting the requested number returned from the information service comprising using voice recognition algorithms to parse the audible response returned from the information service into a series of numbers that comprise the requested phone number for the purpose of providing a place for the instructions to reside in various types of media.

Regarding claim 19, Johnson discloses the computer program code (which reads on 0034) for storing the requested phone number returned from the information service within the mobile phone comprises (which reads on "If the user chooses to download the telephone number to his wireless device 102, step 206, the server 116 sends the telephone number as a data message to the wireless device 102., After the directory information is received, step 208, an application in the wireless device 102 creates an entry in its telephone book, step 210, and stores the directory information in the entry, step 212. The steps of creating the entry and storing the information can be done in the background, as the result of the user accepting to download the telephone number" as exhibited in figure 2, and as disclosed in paragraphs 0020-0021), having the mobile phone prompt the user whether to store the returned phone number (which reads on paragraphs 0020).

Regarding claim 20, Johnson discloses the computer program code for storing the requested phone number returned from the information service within the mobile phone further comprises

computer program code for having user where to store the mobile phone prompt the returned

phone number (which reads on "If the user chooses to download the telephone number to his

wireless device 102, step 206, the server 116 sends the telephone number as a data message to

the wireless device 102., After the directory information is received, step 208, an application in

the wireless device 102 creates an entry in its telephone book, step 210, and stores the directory

information in the entry, step 212. The steps of creating the entry and storing the information

can be done in the background, as the result of the user accepting to download the telephone

number, When the server 116 downloads the information to the wireless device 102, the

information is in a predetermined format, so the receiving end can readily identify the type of

information and handle it properly. If the information relates to a telephone directory entry, it

may have only two data fields, name and telephone number, or many fields such as the fields

illustrated in FIG. 5. FIG. 5 is an example of a telephone directory 502 for a wireless device on

paragraphs 0020, 0021, and 0027.

Regarding claim 21, Johnson discloses wherein the returned phone number is stored within the

mobile phone's phonebook directory (which reads on paragraphs 0006-0009).

Regarding claim 23, Johnson discloses computer program code for prompting the user whether

to automatically dial the returned phone number (which reads on paragraphs 0020).

Regarding claim 24, Johnson discloses computer program code for storing the requested

phone number within the mobile phone code for having comprises computer program the mobile

phone automatically store the returned from the information service returned phone number

within the mobile phone's phonebook directory (which reads on paragraphs 0006-0009).

Regarding claim 26, Johnson discloses a computer program product for storing a phone

number (which reads on 0034) within a mobile, said phone service, the method comprising:

placing a call to an information quested phone number (which reads on paragraphs 0006-0009),

requesting that the requested phone number be sent in an SMS text message to the mobile phone;

and receiving an SMS text message containing the requested phone (which reads on paragraphs

0020) phone number and storing the phone number contained in the SMS text message (which

reads on paragraph 0021). However Johnson fails to specifically discloses detecting that a

number of the called information service is stored in a predetermined table of information service

numbers activating a process for detecting and storing a received phone number responsive to the

detecting the number of the called information service being stored in the predetermined table of

information service numbers.

The examiner contends that this limitation would have been obvious to one of ordinary

skill in the art, since Johnson discloses the use of "the user chooses to download the direction the

server sends the instruction to the wireless device the instruction it creates an enry in a

appropriate directory and stores the direction in this entry. If the user has trouble recalling the

direction, the user can lool up the entry corresponding to his friend in the direction directory and

the direction is displayed on his wireless device" (as disclosed in paragraph 0031, and 0032) for

the purpose of locating and using the information received when it is needed.

Regarding claim 27, Johnson discloses computer program Code for Opening SMS; and

Computer program Code (which reads on 0034) for having the SMS text message the mobile

phone prompt the mobile phone user whether to automatically dial the phone number contained

in the SMS text message (which reads on "In addition to prompting whether the user wants to be

automatially connected to the destination party, the data message can be sent via short message

service" as disclosd in paragraphs 0020). However, Johnson fails to specifically disclose

opening the SMS text message.

The examiner take official notice that opening the SMS text message would have been

obvious to one skill in the art for the purpose to obtain the information contained in the message.

Regarding claim 28, Johnson discloses Computer program Code for opening the SMS

text message, computer program code (which reads on 0034) for having the mobile phone

prompt the mobile phone user whether to store the phone number contained in the SMS text

message (which reads on paragraphs 0006-0009 and 0020) before the storing the phone number

contained in the SMS text message (which reads on "the user chooses to download the

information the server sends the information as a data message to the wireless device" paragraph

0024). However, Johnson fails to specifically disclose opening the SMS text message.

The examiner take official notice that opening the SMS text message would have been

obvious to one skill in the art for the purpose to obtain the information contained in the message.

Regarding claim 29, Johnson discloses computer program code (which reads on 0034)

for having the mo- bile phone prompt the user where to store the phone number contained in the

SMS text message (which reads on paragraphs 0024).

    Regarding claim 30, Johnson discloses the phone number contained in the SMS text stored within the mobile message is phone's phonebook directory (which reads on paragraphs 0020-0021).

    Regarding claim 32, Johnson discloses a method of storing a phone number within a mobile phone, within a mobile, said phone service, the method comprising: placing a call to an information quested phone number (which reads on paragraphs 0006-0009), requesting that the requested phone number be sent in an SMS text message to the mobile phone; and receiving an SMS text message containing the requested phone (which reads on paragraphs 0020) phone number and storing the phone number contained in the SMS text message (which reads on paragraph 0021). However Johnson fails to specifically discloses detecting that a number of the called information service is stored in a predetermined table of information service numbers activating a process for detecting and storing a received phone number responsive to the detecting the number of the called information service being stored in the predetermined table of information service numbers.

    The examiner contends that this limitation would have been obvious to one of ordinary skill in the art, since Johnson discloses the use of "the user chooses to download the direction the server sends the instruction to the wireless device the instruction it creates an entry in a appropriate directory and stores the direction in this entry. If the user has trouble recalling the direction, the user can look up the entry corresponding to his friend in the direction directory and the direction is displayed on his wireless device" (as disclosed in paragraph 0031, and 0032) for the purpose of locating and using the information received when it is needed.

Regarding claim 33, Johnson discloses detecting the re- quested phone number that the

information service connected the mobile phone to comprises obtaining the in- formation via a

network query and response (which reads on paragraphs 0006-0009).

Regarding claim 34, Johnson discloses storing the re- number returned from the

information service within the mobile phone comprises having the mobile phone prompt the user

whether to store the re- turned phone number (which reads on paragraphs 0020).

Regarding claim 35, Johnson discloses essentially all the claimed invention as set fourth

in the instant application, further Johnson discloses number returned from storing the

information (which reads on paragraphs 0006-0009).

Regarding claim 36, Johnson discloses the returned phone the mobile phone's

phonebook directory (which reads on paragraphs 0006-0009).

2.   Claims 7, 10, 22,25,31,37 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Johnson in view of Borella and further in view of MoIne (U. S. Patent Number 5,689,547).

Regarding claim 7, The combination of Johnson in view of Borella discloses returned

phone number is stored on the mobile phone (which reads on paragraphs 0006-0009). However

Johnson in view of Borella fails to disclose a returned phone number is stored on a SIM card

attachable to the mobile phone.

In the same field of endeavor, MoIne discloses a cellular radiotelephones including means

for generating a search request data signal and receiving a telephone number from a network

directory database and related methods. In addition MoIne discloses a returned phone number is

stored on a SIM card attachable (which reads on "The operator then locates the number, confirms

it and inquires as to whether the number is to be transmitted verbally, transferred over SMS into

a given memory location of the subscriber's SIM card or both" as disclosed in column 1 lines 53-

56).

Therefore, it would have been obvious to one of ordinary skill at the time the invention

was made to modify Johnson by specifically providing for a SIM card attachable for the purpose

of updating a mobile phone.

Regarding claim 10, The combination of Johnson in view of Borella discloses storing

the requested phone number returned from the information service within the mobile phone

comprises having the mobile phone automatically store the returned phone number. However

Johnson in view of Borella fails to disclose a SIM card attachable.

In the same field of endeavor, MoIne discloses a cellular radiotelephones including means

for generating a search request data signal and receiving a telephone number from a network

directory database and related methods. In addition MoIne discloses a SIM card attachable

(which reads on column 1 lines 59-65).

Therefore, it would have been obvious to one of ordinary skill at the time the invention

was made to modify Johnson by specifically providing for a SIM card attachable for the purpose

of updating a mobile phone.

Regarding claim 22, The combination of Johnson in view of Borella discloses returned

phone number is stored on the mobile phone (which reads on paragraphs 0006-0009). However

Johnson in view of Borella fails to disclose a SIM card attachable.

In the same field of endeavor, MoIne discloses a cellular radiotelephones including means for generating a search request data signal and receiving a telephone number from a network directory database and related methods. In addition MoIne discloses a SIM card attachable (which reads on column 1 lines 59-65).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Johnson by specifically providing for a SIM card attachable for the purpose of updating a mobile phone.

Regarding claim 25, The combination of Johnson in view of Borella discloses storing the requested phone number returned from the information service within the mobile phone comprises having the mobile phone automatically store the returned phone number. However Johnson in view of Borella fails to disclose a SIM card attachable.

In the same field of endeavor, MoIne discloses a cellular radiotelephones including means for generating a search request data signal and receiving a telephone number from a network directory database and related methods. In addition MoIne discloses a returned phone number is stored on a SIM card attachable (which reads on "The operator then locates the number, confirms it and inquires as to whether the number is to be transmitted verbally, transferred over SMS into a given memory location of the subscriber's SIM card or both" as disclosed in column 1 lines 53-56).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Johnson by specifically providing for a SIM card attachable for the purpose of updating a mobile phone.

Regarding claims 31, 37, The combination of Johnson in view of Borella discloses returned phone number is stored on the mobile phone (which reads on column 3 lines 1-67). However Johnson in view of Borella fails to disclose a SIM card attachable.

In the same field of endeavor, MoIne discloses a cellular radiotelephones including means for generating a search request data signal and receiving a telephone number from a network directory database and related methods. In addition MoIne discloses a SIM card attachable (which reads on column 1 lines 59-65).

Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to modify Johnson by specifically providing for a SIM card attachable for the purpose of updating a mobile phone.

Response to Arguments

Applicant's arguments, see pages 9-11, filed 12/19/07, with respect to the rejection(s) of claim(s) 1-37 under 102e have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEILA B. SMITH whose telephone number is (571)272-7847. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith
/Sheila B. Smith/
Examiner, Art Unit 2617
March 11, 2008

/DWAYNE D. BOST/
Supervisory Patent Examiner,
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